

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

| | | |
|--------------------------------|---|----------------------------------|
| NATIONAL STEEL CAR LIMITED, |) | |
| |) | |
| Plaintiff/Counterclaim- |) | |
| Defendant, |) | Redacted - Public Version |
| |) | |
| v. |) | C.A. No. 24-594-JLH-CJB |
| |) | |
| FREIGHTCAR AMERICA, INC., |) | |
| FREIGHTCAR NORTH AMERICA, LLC, |) | |
| JAC OPERATIONS, INC., AND |) | |
| FCA-FASEMEX, LLC, |) | |
| |) | |
| Defendant/Counterclaim- |) | |
| Plaintiffs. |) | |

**NSC’S MOTION FOR LEAVE TO FILE SUR-REPLY LETTER BRIEF IN
OPPOSITION TO DEFENDANTS’ MOTION FOR LEAVE TO AMEND ANSWER TO
SECOND AMENDED COMPLAINT AND COUNTERCLAIMS**

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Dated: October 21, 2025

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FOR THE DISTRICT OF DELAWARE

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Plaintiff National Steel Car Limited (“NSC”) respectfully moves the Court for leave to file a two-page sur-reply letter brief to address six specific misstatements of law and fact raised for the first time by Defendant FreightCar America, Inc., FreightCar North America, LLC, Jac Operations, Inc., and FCA-Fasemex LLC in their Reply Letter Brief in support of their Motion for Leave to Amend their Answer to the Second Amended Complaint and Counterclaims D.I. 135 (the “Reply”). *See also* D.I. 122 (the “Opening” Letter Brief) and D.I. 130 (the “Opposition” Letter Brief”). A copy of the proposed sur-reply is attached as Exhibit 1.

Sur-replies are permitted by this Court to address new arguments or misstatements first raised in reply briefs, in the interest of fairness and clarity. *See, e.g., Chase Bank USA N.A. v. Hess Kennedy Chartered LLC*, 589 F. Supp. 2d 490 (D. Del. 2008) (granting Plaintiff’s sur-reply request directed to “a number of alleged misrepresentations” in a reply brief); *see also Inline*

Connection Corp. v. EarthLink, Inc., 684 F. Supp. 2d 496, 500, n.8; 540 (D. Del. 2010) (granting leave to file a sur-reply “to correct the record” and “ensure that the court has the proper context”); *see also Tridinetworks Ltd. v. Signify N. Am. Corp.*, C.A. No. 19-1063-CFC-CJB, 2020 U.S. Dist. LEXIS 95357, at *13 n.6 (D. Del. June 1, 2020) (Burke, J.) (“Because this argument could have and should have been raised in the opening brief, it has been waived”); *Ad Hoc Comm. of Equity Holders of Tectonic Network, Inc. v. Wolford*, 554 F. Supp. 2d 538, 562 n.168 (D. Del. 2008); *Whitfield v. Pathmark Stores, Inc.*, 971 F. Supp. 851, 853 n.1 (D. Del. 1997).

NSC respectfully requests leave to file the attached sur-reply to address six specific and material misstatements in the Reply—two of law and four of fact.

Legal Misstatements

First, Defendants assert that NSC “does not dispute” it would suffer prejudice under Rule 16. *See* Reply at 1-2. However, Defendants did not raise Rule 16 prejudice in their Opening brief, which focused exclusively on Rule 15. *See* Opening at 3. *Second*, Defendants argue (again for the first time) that NSC’s objections to Interrogatory No. 15 substantively bear on inequitable conduct, rather than merely evidencing FreightCar’s diligence. *See* Reply at 1. These new legal arguments should be disregarded.

Factual Misstatements

Defendants also introduce several new factual assertions in their Reply brief, including: (i) that their lack of diligence is excused by the need to obtain further evidence regarding all of the inventors’ knowledge of the Cyclopedias; (ii) that their failure to plead cumulateness in the Opening brief is excusable; (iii) that cumulateness is undermined because a Cyclopedia disclosed during prosecution was “significantly compressed,” rendering its drawings nearly

illegible; and (iv) that inequitable conduct arose from the inventors “knowingly [taking] advantage of the PTO” by not affirmatively correcting the Examiner’s alleged error, rather than merely failing to disclose the 1946 Cyclopedia. *See* Reply at 1-2.

This Court has repeatedly held that factual arguments raised for the first time in reply briefs are improper and will not be considered. *See Rockwell Techs. LLC v. Spectra-Physics Lasers, Inc.*, C.A. No. 00-589-GMS, 2002 U.S. Dist. LEXIS 5180, at *8 (D. Del. Mar. 26, 2002) (“[Plaintiff’s] tactic of reserving new arguments for its reply brief amounts to impermissible ‘sandbagging.’”) (citing *Jordan v. Bellinger*, C.A. No. 98-230-GMS, 2000 U.S. Dist. LEXIS 19233, at *17 n.7 (D. Del. Aug. 28, 2000)); *Guardant Health, Inc. v. Found. Med., Inc.*, C.A. No. 17-1616-LPS-CJB, 2020 U.S. Dist. LEXIS 87453, at *28 n.14 (D. Del. Jan. 7, 2020) (Burke, J.) (declining to consider a “more detailed argument” raised for the first time in a reply brief).

NSC respectfully submits that it is entitled to address the new arguments raised in Defendants’ Reply and therefore requests that the Court grant leave to file the attached sur-reply.

Pursuant to D. Del. LR 7.1.1, NSC certifies that it has made reasonable efforts to reach agreement on this motion. On October 14, 2025, counsel for NSC met and conferred with counsel for Defendants regarding NSC’s request for a sur-reply. Defendants oppose the request.

Accordingly, NSC respectfully requests that the Court grant leave to file the sur-reply letter brief attached hereto as Exhibit 1.

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Dated: October 21, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on October 21, 2025, this document was served on LitFCAL.001L@knobbe.com and on the persons listed below in the manner indicated:

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*Attorneys for Plaintiff National Steel
Car Limited*

Exhibit 1

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FOR THE DISTRICT OF DELAWARE

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**NSC'S SUR-REPLY LETTER BRIEF IN OPPOSITION TO DEFENDANTS'
MOTION FOR LEAVE TO AMEND ANSWER TO SECOND AMENDED
COMPLAINT AND COUNTERCLAIMS**

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Dated: October 21, 2025

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October 21, 2025

VIA CM/ECF & HAND DELIVERY

The Honorable Christopher J. Burke
J. Caleb Boggs Federal Building
844 N. King Street, Unit 28, Room 2325
Wilmington, DE 19801-3555



Re: *National Steel Car Limited v. FreightCar America, Inc.*, Civ. No. 24-00594

Dear Judge Burke:

I. Defendants Reply Improperly Raises New Legal Arguments

Defendants' Reply (D.I. 135) introduces new arguments that should be disregarded. Courts routinely reject such tactics. *Rockwell Techs. LLC v. Spectra-Physics Lasers, Inc.*, C.A. No. 00-589-GMS, 2002 U.S. Dist. LEXIS 5180, at *8 (D. Del. Mar. 26, 2002) ("reserving new arguments for its reply brief amounts to impermissible 'sandbagging.'").

Defendants did not argue in their opening brief that prejudice to NSC (or a lack thereof) affects the Rule 16 analysis. *See* Reply at 1-2. In their reply, they cite an out-of-district case to argue for the first time that the alleged lack of prejudice can impact the Rule 16 *diligence* analysis in their favor. *See id.* at 2 ("courts may find good cause by considering the movant's diligence *in light of* the absence of prejudice to the non-movant.") (emphasis added). But the District of Delaware has repeatedly declined to consider prejudice under Rule 16 absent an initial showing of diligence. *See, e.g., United Therapeutics Corp. v. Liquida Techs., Inc.*, C.A. No. 23-975-RGA-SRF, 2024 U.S. Dist. LEXIS 206820, at *2-4 (D. Del. Nov. 12, 2024) (declining to consider prejudice in diligence analysis); *Int'l Constr. Prods. LLC v. Caterpillar Inc.*, C.A. No. 15-108-RGA, 2024 U.S. Dist. LEXIS 18537, at *2 (D. Del. Feb. 2, 2024) (holding that good cause exists when the deadline "cannot reasonably be met," and rejecting consideration of prejudice or other factors).

Defendants also argue for the first time in their Reply that NSC's objections to Interrogatory No. 15 substantively relate to inequitable conduct, rather than merely evidencing FreightCar's alleged diligence. Reply at 1. NSC's decision to stand on its objections cannot justify a negative inference or sanction. In fact, contemporaneous evidence confirms that neither NSC nor the inventors possessed the 1946 Cyclopedia during prosecution of the '892 Patent. *See* Ex. K, NSC0006798; Ex. L, Jewell Decl. ¶¶ 3-5.

These new legal arguments should be disregarded.

II. Defendants Reply Improperly Raises New Factual Arguments

Defendants' Reply also introduces new factual assertions not raised in their Opening brief, which should be disregarded. *Rockwell Techs.*, 2002 U.S. Dist. LEXIS 5180, at *8.

First, Defendants claim their lack of diligence is excused because they needed to wait for evidence regarding each inventor. Reply at 1. But they received documents in February 2025 showing that all three inventors knew of various Cyclopedias. *See* Ex. J, Adams Declaration ¶ 2; Ex. K, NSC0006798; *see also* Exs. B, C. This argument is untimely and should be disregarded.

Second, Defendants argue for the first time that their failure to plead lack of

cumulativeness is excusable. It is not. Failure to plead non-cumulativeness is fatal to an inequitable conduct claim. *See Analog Devices, Inc. v. Xilinx, Inc.*, No. 2019-cv-02225-RGA, 2021 WL 466859, at *2-*4 (D. Del. Feb. 9, 2021). Defendants also newly assert that cumulateness is irrelevant because a disclosed Cyclopedia was “significantly compressed,” rendering its drawings purportedly nearly illegible. Reply at 1-2. But as shown in Ex. I, the key features are clearly discernable to a Patent Examiner. *See* Ex. I at 354, 356. This argument also should be disregarded.

Third, Defendants now contend that the alleged inequitable conduct stemmed from the inventors “knowingly [taking] advantage of the PTO” by not affirmatively correcting the Examiner’s alleged error in his reasons for allowance, and not merely by failing to disclose the 1946 Cyclopedia. Defendants offer no justification for withholding this argument from their Opening brief. This argument too should be disregarded.

Respectfully Submitted,

/s/ *Andrew E. Russell*

Andrew E. Russell (No. 5382)

cc: Clerk of Court (by CM/ECF & Hand Delivery)
All Counsel of Record (by CM/ECF & Email)

Exhibit J

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

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| FCA-FASEMEX, LLC, |) | |
| |) | |
| Defendant/Counterclaim- |) | |
| Plaintiffs. |) | |

**DECLARATION OF KEVIN ADAMS IN SUPPORT OF
NSC’S OPPOSITION TO FREIGHTCAR’S MOTION TO AMEND**

I, Kevin Adams, declare as follows:

1. I am an attorney with the law firm Ice Miller LLP and counsel of record for Plaintiff National Steel Car (“NSC”) in the above-captioned matter. I have personal knowledge of the matters set forth herein and if I am called upon to testify, I could and would testify competently thereto.

2. NSC’s production NSC_003 contains documents bearing Bates numbers NSC003580-011421. Therefore, the document bearing Bates number NSC0006798 was included in NSC’s production NSC_003 and produced on February 26, 2025.

I declare under the penalty of perjury that the foregoing is true and correct.

Dated: October 21, 2025

/s/ Kevin Adams

Exhibit K

Exhibit L

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

NATIONAL STEEL CAR LIMITED,

Plaintiff,

v.

FREIGHTCAR AMERICA, INC.,
FREIGHTCAR NORTH AMERICA, LLC,
JAC OPERATIONS, INC., AND FCA-
FASEMEX LLC

Defendants.

)
)
)
)
) C.A. No. 24-594-JLH-CJB
)
)
)
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)
)
)

DECLARATION OF LAURA JEWELL

I, Laura Jewell, declare as follows:

1. I have personal knowledge of the matters set forth herein and if I am called upon to testify, I could and would testify competently thereto.
2. I am Director of Process Control for Product Engineering at National Steel Car Limited ("NSC"). As part of my duties, I maintain Product Engineering's physical and electronic storage of documents and regularly search and retrieve documents and information from the same.
3. I understand that Defendants have identified the 1946 Car Builders' Cyclopedia of America Practice (the "1946 Cyclopedia") in this litigation. The portions of the 1946 Cyclopedia identified by Defendants are attached hereto as Exhibits A and B.
4. NSC keeps multiple "Cyclopedias" of various editions in its Product Engineering and Marketing departments. I have conducted searches for the 1946 Cyclopedia in Product Engineering and Marketing's physical and electronic documents. I did not find the 1946 Cyclopedia in Product Engineering or Marketing's physical and electronic documents.
5. I would not expect another department (besides Product Engineering and Marketing) at NSC to have a copy of a Cyclopedia. To my knowledge, NSC did not have a copy of the 1946 Cyclopedia prior to my searches.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Date: October 17, 2025


Laura Jewell

EXHIBIT A

CAR BUILDERS' CYCLOPEDIA

1946

Philip L. Keister
1946 - 1962



Presented by

Philip L. Keister
Jessica Keister Robbins

1946 Car Builders' Cyclopedia Of American Practice

Definitions and Typical Illustrations of Railroad and Industrial
Cars, Their Parts and Equipment; Cars Built in America
for Export to Foreign Countries; Descriptions and
Illustrations of Shops and Equipment Employed
in Car Construction and Repair

Seventeenth Edition—1946
First Edition—"Car Builders' Dictionary"—1879

Compiled and Edited
for the
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(Formerly Master Car Builders' Association)

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| Third | 1895 | Twelfth | 1928 |
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| Sixth | 1909 | Fifteenth | 1940 |
| Seventh | 1912 | Sixteenth | 1943 |
| Eighth | 1916 | Seventeenth | 1946 |
| Ninth | 1919 | | |

EXHIBIT B

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Philip L. Keister
1946 - 8/62



Presented by

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1946 Car Builders' Cyclopedia Of American Practice

Definitions and Typical Illustrations of Railroad and Industrial
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| Seventh | 1912 | Sixteenth | 1943 |
| Eighth | 1916 | Seventeenth | 1946 |
| Ninth | 1919 | | |